REMARKS

This is in full and timely response to the above-identified Office Action. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim Amendments

Claim 26 has been amended in the manner suggested in paragraph #8 of this Office action. This amendment overcomes the objection set forth in said paragraph.

Rejections Under 35 USC § 102

1) The rejection of claims 11-13, 26 and 28 under 35 USC § 102(b) as being anticipated by Cass is respectfully traversed.

In paragraph #5 of this Office Action it is stated that Cass shows various elements (1111, 1112, 1121, etc.,) are printed on a page which indicate links to web pages, as seen in Figs. 21 and 22. These elements (1111, 1112, etc.) are the communication marks (instead of the "X" marks as argued by applicant) and are URL's or addresses to web sites over the Internet, whereby a URL address can be interpreted as a "location where an external communication ladders is stored." The communication mark is **selected** when the user writes an "X" over the specified communication marks. **Because of this**, one of ordinary skill in the art can still interpret the claims, as currently amended as being taught by Cass. (Emphasis added)

The rejection is firstly traversed in that the anticipation does not require the consideration of a person of ordinary skill, nor do the claims require the "selection" step which is stated as being key to the "interpretation" of the claims.

Further claim 11 calls for:

A method for providing automatic communication addressing comprising the steps of:

receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document at a final addressee destination;

without adding any address information, scanning the document to obtain at least one communication mark, if one is present, on the hardcopy;

decoding the communication mark to obtain at least one Internet address from said communication mark that is different from the final addressee destination;

automatically accessing a site for the Internet address and retrieving at least one communications address;

inputting said communication address into an address function of a communication device; and

initiating a communication of said information to said communication address through said communication device;

wherein said communication mark is a storage address to a location where an external communication address is stored. (Emphasis added)

It is submitted that adding the mark "X" is necessary in Cass for "selection" of one of a number of elements. Claim 11 calls for the document which is scanned to be free of added information. In Cass the "selection" mark "X" is made before the return fax containing the download orders is scanned, and therefore must be considered to be "added information" in the form of a designation of which element the address information is to seek out. It is therefore submitted that the elements which are present on the fax which is received in Cass are useless without the addition of the information as to which of the elements needs to be searched and data downloaded.

Claims 26 and 28 contain corresponding limitations. These claims are also free of anticipation for the reasons set forth above in connection with claim 11.

Rejections Under 35 USC § 103

1) The rejection of claims 2-5, 7-10, 14-18, 20, 22, 24, 25, 27, 29 and 30 under 35 USC § 103(a) as being unpatentable over Witek in view of Li et al., is respectfully traversed.

Witek discloses a system wherein following the receipt of a fax, the data is stored as a pict fax file 15 and then is processed by OCR software – see column 2, lines 42 – column 3, line 2.

> In some cases, many faxed transmissions will be received in a short period of time and **multiple pict fax files 15 will be created**. A control code portion 22 is typically used to monitor the fax receipt software program 14 to insure data is not lost and that proper management of multiple files is carried out by the computer 12. The pict fax files 15 may either be prioritized by time or by a fax transmitting urgency or a like priority. **Once one or more pict fax files 15 have been formed via program 14, optical character recognition (OCR) 16 is used to process the pict fax file 15.** If more than one fax file 15 exists within memory 13 at one point in time, control code 22 determines via the priority scheme discussed above, which pict fax file 15 is processed in which order by the software 16. **The primary purpose of the OCR software 16 is to scan** one or more pict fax files 15 **and translate** those pict fax files 15 **from a non-text format to a text format.** The text format, which is stored in text fax file 17, may be represented in one of many manners such as ASCII, binary, BCD, and/or the like. In one form, the OCR software 16 converts only a portion of the pict fax file 15 to text, and in another form the OCR software 16 will convert the entire pict fax file 15 to text fax file 17. **In either case, the OCR software 16 is converting the pict fax file 15 to a text fax file for at least one primary purpose. This primary purpose is to determine from the faxed data any information which is needed to electronically log or track the fax transmission and determines where to properly route the fax transmission** (i.e., a fax destination). (Emphasis added)

This reference discloses that the non-text/image data is typically ignored and data which can be read and converted into text using OCR, is examined – see column 3, lines 16-20:

> Typically, these **drawings** within the pict fax file **are not converted to text** by the OCR software 16, but remain in a graphics format. The **OCR software 16 is typically looking for one or more pieces of information from this "cover sheet"**. (Emphasis added)

Thus, in summary, the Witek arrangement is directed to reading the fax and determining from text which is converted via OCR what routing of the fax is necessary.

In this rejection, it is stated that in Witek the communication mark is decoded in a manner which obtains as least first and second communication addresses wherein the first address is for a first communication mode and the second address is for a second different mode. However, this in error. The following sections have been quoted as being the source of this disclosure.

Column 2 line 65 – column 3, line 2:

> This primary purpose is to determine from the faxed data any information which is needed to electronically log or track the fax transmission and determines where to properly route the fax transmission (i.e., a fax **destination**). (Emphasis added)

Column 3, line 37 – column 4, line 19

> In many cases, when writing a cover sheet for a fax, or when generating a fax cover sheet via computer, mistakes are made. **For example, typos may occur, names may be misspelled, or the OCR software may not have properly recognized the name on the coversheet.** In this case, the **custom pattern recognition 18 either contains multiple strings** which identify a particular user (i.e., "David Johnson", "Dave", "johnson", "Dave Johnson", "Johnson", "dave", "david", "jonson", "Jonson" etc.) **or employs a pattern recognition scheme** which is used in spelling checkers

to identify misspelled words in a "error minimization" manner. This error scheme which is used in spelling checker matches misspelled or mis-recognized words to a list of valid words and determines which valid word in the list of valid words either closely matches or significantly matches the misspelled word read from file 17. This error correction system is typically performed by a numerical weight factor which is generated on a character-by-character comparison basis between strings stored via code 18 and strings parsed in the text fax file 17. For example, the parsed string from the text fax file 17 may be, for example, "Riek". In the database accessed by code 18, no "Reik" exists. Instead, the code 18 identifies a "Rick", "Rich", "Rieker", etc. The code 18 uses a numerical error weight scheme to determine which, if any, string from "Rick", "Rich", "Rieker", etc. is closest to the parsed term "Reik" from the file 17.

Once the code 18 recognizes **one or more destinations** of the fax received via the modem 10, the fax is routed via an electronic mail program 20 to the proper destination. The proper destination may be identified by the E-mail program 20 via an address, a user name, a numerical value, a network identifier, or any like identification means which can be found or identified via one or more of code 18 and E-mail program 20. E-mail program 20 can communicate across either telecommunication lines, local area networks, token passing networks, serial computer interfaces, parallel computer interfaces, buses, or any like computer communication means to transmit the faxes received by modem 10 to the destinations identified by the customer pattern recognition code 18. (Emphasis added)

Column 4, lines 57-67:

In some cases, either the **OCR software 16** will not properly convert the pict faxed file 15, or the custom pattern recognition 18 will either not notice a user connected via the office network or not be able to determine a user within the proper error tolerances (see above). **In these cases, the fax will either be stored by the control code in a default storage location for access at a subsequent time or will be transmitted via the office network to a default computer which can be accessed by a system administrator** or secretary who is

> then responsible for the hand-routing of the faxes which are not properly handled by computer 12. In another form, the **fax can simply be printed via a hardware printer 24 and routed by hand** via human personnel or stored to a default disk space for access by all users of computers 26. (Emphasis added)

Column 6, lines 48-63:

> Once step 106 is performed, a step 108 checks **the text fax file 17** or FIG. 1 to determine if a valid recipient or destination or a plurality of valid recipients/destinations are found from documentation within the fax received by the serial computer interface. If the pattern recognition code 18 cannot find a valid destination via step 108, then the fax is routed to a default computer, printed to a printer, and/or stored at a default disk storage area. Optionally, this situation **wherein a fax destination is not properly identified can be flagged to a network operator, secretary or user so that the unrecognizable destination may be fixed in the future.**
>
> Once a destination is recognized, a step 112 is used to electronically send the fax to the destination via electronic media or an E-mail protocol. (Emphasis added)

As will be appreciated, the disclosure is directed to the use of **OCR** and there is no mention of decoding the communication mark. The decoding is of the text data which can be read and decoded by the OCR software. It also should be noted that while there is mention of the possibility of one or more destinations for any given fax, there is no mention of modes per se let alone first and second different modes. It must be assumed, in the absence of any disclosure to the contrary, that the same mode is contemplated for each of the fax deliveries just mentioned.

It is submitted that the rejection is untenable for at least these reasons. Clearly, the rejection is based on the erroneous assumption that the communication mark (as different from the text) is being decoded. As will be appreciated from the above quotes (which form the basis for the rejection), this position is incorrect and the rejection thus fails to establish a *prima facie* case of obviousness.

Li et al. discloses an arrangement which is directed to preventing document degradation which commonly occurs when a facsimile is rescanned and retransmitted one or more times. See column 11, lines 35-40 wherein it is set forth that:

> This process of re-transmitting the consolidation sheet to **regenerative facsimile** machines which regenerates duplicates of the original documents and new consolidation sheets, can be **continued indefinitely**. Unlike conventional facsimile processing, the image quality of the duplicate pages does not decrease with added transmissions.

Thus, the basic focus of the Li et al. arrangement is to be able to reproduce both symbol and text so that no matter how many times the document is copied and retransmitted, neither the symbol, such as bar code, nor the text degrades. While there is mention that the symbol 45 can be encoded to contain various pieces of information such as column 8, lines 4 – 34, there is nothing that would suggest to the hypothetical person of ordinary skill that the basic arrangement of Witek should be reversed and the communication mark and not the text should be examined/decoded. This type of reversal, of course, would result in all of the teachings of Witek being rendered useless and the need for a whole new strategy introduced.

> "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. ***In re Ratti***, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." M.P.E.P. § 2143.02.

It is further submitted that when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

2) The rejection of claims 19 and 31-33 under 35 USC § 103(a) as being unpatentable over Witek in view of Li et al. and further in view of Cass is respectfully traversed.

This rejection is traversed in that the basic combination of Witek and Li et al. is untenable for the reasons advanced above. It is further untenable in that in light of Cass being erroneously alleged to meet the requirement that no additional information is added. As noted above, marking the "X" mark on the required elements constitutes the addition of further information as to which of the elements has been selected. Accordingly, a *prima facie* case of obviousness is not established.

Conclusion

It is respectfully submitted that all of the pending claims are allowable over the cited art for at least the reasons advanced above. Favorable reconsideration and allowance of this application is courteously solicited.

Respectfully submitted,

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